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7590	02/18/2005		EXAMINER	
Ferdinand Schermel RR# 10 Brampton, ON L6V 3N2 CANADA			CASTELLANO, STEPHEN J	
			ART UNIT	PAPER NUMBER
			3727	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/872,914

Filing Date: June 01, 2001

Appellant(s): SCHERMEL, FERDINAND

Ferdinand Schermel

Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 18, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter is not required when the appellant is not represented by a practitioner.

(6) Grounds of Rejection to be Reviewed on Appeal

Although not required to provide separate grounds of rejection, the prose appellant has submitted section (vi) Grounds of rejection on pages 2 and 3 of the brief.

Appellant's brief presents arguments relating to drawing objections and claim objections. These issues relate to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. Therefore, grounds of rejection 1 and 2 relating to drawing objections and claim objections, respectively, have been removed.

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The appellant's statement of the grounds of rejection is substantially correct. The changes are as follows: Grounds of rejection 1 and 2 have been removed. Grounds of rejection 3 pertains to two rejections, a first rejection under 112, first paragraph involving new matter and a second rejection under 112, second paragraph involving indefiniteness. Grounds of rejection 3 has been replaced with grounds of rejection 3a pertaining to the 112, first paragraph rejection and grounds of rejection 3b pertaining to the 112, second paragraph rejection. Grounds of rejection 6 and grounds of rejection 7 are actually the same and have been referred to collectively as grounds of rejections 6 and 7.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Patents:

6,347,847	Tiramani et al.	issued : 02/2002
6,176,559	Tiramani et al.	issued : 01/2001
4,691,840	Ferbrache	issued : 09/1987
3,269,580	Tolbert, Jr.	issued : 08/1966

Prior art admissions:

Appellant makes the following statement at lines 8-10 of the Grounds of Rejection 1.

Drawing Objections section on page 3 of the brief filed November 18, 2004: "the original drawings combined with the written disclosure, the various configurations are obvious and

simply duplication and in any way adds new matter or additional features that was not part of the original disclosure.”

Appellant states the following at lines 7 and 8 of page 16 of the brief filed November 18, 2004: “Both Tiramani’s and the luggage industry have devices having the same base perimeter dimensions of approximately 170 inches.”

Appellant has previously stated that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No.23.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Grounds of Rejection 3a:

Claims 1, 3-6, 9, 10, 22 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed doesn’t contain support for a modular wheeled container system comprising a wheeled container, a first attachable container which rests on top of said wheeled container and a second attachable container which rests on top of said first attachable container as recited in claim 1. Also, the base perimeter greater than 55 inches as recited in claim 1 is not supported by the original specification. **This is a new matter rejection.**

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Grounds of Rejection 3b:

Claims 1, 3-6, 9, 10, 22 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it contains an optional limitation, “an optional second attachable container.” The metes and bounds of the claim, that is, the scope of the claim can not be determined since it can’t be determined if the second attachable container is part of the claim or not.

Claim 1 contains the limitation “the a base perimeter” in line 26. There is no antecedent basis for this term. Claim 1 is confusing because it can’t be determined whether applicant is introducing the “base perimeter” element or referring to a previous recitation of the “base perimeter.”

Grounds of Rejection 4:

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 ('559) and Tiramani 2 ('847).

Each of the Tiramani references disclose the invention except for capacity of the container of 32 gallons and the base perimeter of 55 inches. Trash containers of 32 gallon capacity and 55 inch base perimeter are well known. It would have been obvious by engineering design choice to modify the size of the container to be 32 gallons in order to make the volume correspond to any quantity desired. No criticality has been assigned to the 32 gallon capacity. It would have been obvious by engineering design choice to modify the size of the base perimeter

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to be greater than 55 inch to have a base which is large enough in perimeter and area to be stable to be stacked upon without concern of the stack toppling. No criticality has been assigned to the 55 inch perimeter dimension.

Grounds of Rejection 5:

Claims 3-6, 9, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and Tiramani 2 in view of Tolbert, Jr. (Tolbert).

The Tiramani references disclose the invention except for the additional wheeled container secured to an attached container. From the Tiramani references, it is well known that the combination of a wheeled container with an attachable container is old and well known. Tolbert teaches a plurality of side-by-side wheeled containers which are connected by their handles and roll together as a single entity in a tilted position. It would have been obvious to add another wheeled container with an attachable container by duplication of part and as taught by the Tiramani references and to connect the two wheeled containers by their handles as taught by Tolbert to provide a single entity which can be rolled in a tilted position as a single entity eliminating the need to make a trip with each container individually to transport all the containers to the same point from the same point.

Grounds of Rejection 6 and 7:

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Tolbert as applied to claim 6 above, and further in view of Ferbrache.

The combination discloses the invention except for the specific handle of Ferbrache.

Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

(10) Response to Argument

Grounds of Rejection 3a: 112, first paragraph rejection (new matter)

Appellant makes the following statement at lines 5-10 of the Grounds of Rejection 1.

Drawing Objections section on page 3 of the brief filed November 18, 2004: “In this case not even the original Fig. 1 or the provisional patent drawing or amended Fig. 1 drawings (appendix 2) are necessary for someone skilled in the art to understand and reproduce the invention from the written portion of the disclosure, but with the original drawings combined with the written disclosure, the various configurations are obvious and simply duplication and in any way adds new matter or additional features that was not part of the original disclosure.” This statement concedes that added the provisional patent drawing and amended Fig. 1 (appendix 2) are new matter.

Grounds of Rejection 3b: 112, second paragraph rejection

Appellant explains that the second container becomes part of claim 1 when a condition is met. This is clearly indefinite because conditional limitations are indefinite. The condition mentioned is that the second container is to be added if the combined height of wheeled

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container and the first attachable container is not high enough for ergonomically comfortable tilting and rolling. It seems clear that for two people, one person who is relatively short with a high tolerance for discomfort and the other person who is relatively tall with a low tolerance for discomfort, this condition has very different meaning. The tall person would experience discomfort at almost any height and would prefer the addition of another container, whereas the short person would prefer a lower profile configuration and would never prefer the addition of another container. This is indefinite since the invention would be dependent on the user's preference.

Appellant doesn't believe that the dependent claims should have been included in this rejection. Of course they should, dependent claims have all the limitations of the claims from which they depend. The dependent claims do not state anything that would add clarity or remove the indefiniteness brought about by the conditional limitation.

Grounds of Rejection 4: 103 Rejection of Tiramani 1 and Tiramani 2

Appellant concedes the "greater than 55 inches" base perimeter limitation on lines 7 and 8 of page 16 of the brief filed November 19, 2004.

Appellant hasn't rebutted or seasonably challenged the statement in the rejection that 32 gallon (capacity) trash containers are well known. Further, appellant's specification doesn't specify any criticality to a two container rigid entity of greater than 32 gallon. If one of the two containers of the two container rigid entity has a 32 gallon capacity, the rigid entity will have a total capacity of greater than 32 gallons.

Grounds of Rejection 5: 103 Rejection of Tiramani 1 and Tiramani 2 in view of Tolbert

Appellant states that Tolbert isn't tilted. It is evident that all wheeled container tilt at least minimally due to clearances and tolerances associated with the free movement of the wheel mechanisms.

Grounds of Rejection 6 and 7: 103 Rejection of Tiramani 1 and Tiramani 2 in view of Tolbert and further in view of Ferbrache

Appellant states that the placement of the Ferbrache handle would interfere with the operation of Tiramani's handle. Ferbrache's handle is replacing the Tiramani handle. Therefore, there is no interference.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Stephen J. Castellano
Primary Examiner

sjc

Conferees:

lwy *[Signature]*
njk *[Signature]*